

AMENDMENTS TO THE DRAWINGS:

The attached one (1) Replacement Drawing Sheet includes changes to Fig. 6. The one (1) sheet, which includes Fig. 6, replaces the original sheet including Fig. 6. In Fig. 6, the reference number for the receiver unit has been corrected as 302, as suggested by the Office Action.

Attachment: One (1) Replacement Sheet.

REMARKS

Claims 18-25, 27-31 and 33-37 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to the objection to the Drawings, the accompanying Replacement Drawing Sheet includes changes to Fig. 6. The one (1) sheet, which includes Fig. 6, replaces the original sheet for Fig 6. In Fig. 6, the reference number for the receiver unit has been corrected as suggested by the Office Action. Approval and entry are respectfully requested.

Claims 18 to 24, 27, 33 and 36 to 37 were rejected under 35 U.S.C. § 112, first paragraph, as failing to satisfy the enablement requirement.

It is respectfully submitted that the specification discloses the subject matter of claim 18 (and its dependent claims) and its feature in which the traffic information does not make use of all of the options and is always at least one of coded, transmitted, and decoded according to the subset. (See, e.g., page 5, line 30 to page 6, line 11; page 9, line 31 to page 10, line 3; page 11, lines 20–30). In particular, digitally coded traffic information does not make use of all the options, and is always at least one of coded, transmitted, and decoded according to the subset is an elaboration of the digitally coded traffic information.

It is also respectfully submitted that the specification discloses the subject matter of claim 27 and its feature of transmitting unit for transmitting a signal including the digitally coded traffic information. (See, e.g., page 11, lines 14–24).

It is respectfully submitted that the specification discloses the subject matter of claim 33 and its feature of receiving unit for receiving a signal that includes the digitally coded traffic information. (See, e.g., page 13, line 10 to 20).

Accordingly, the rejected claims are enabled at least for these reasons.

If the Office maintains these enablement rejections, it is respectfully requested, in accordance with the principles of compact prosecution, that the Office articulate, on the record and with specificity sufficient to support a prima facie case of non-enablement, the factual basis on which it is asserted that it would be beyond the level of ordinary skill in the

art to make and use the claimed subject matter without undue experimentation. (MPEP §2164.01).

In particular, and as further regards the enablement rejections of the claims, it is respectfully submitted that the Final Office Action's assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, it is axiomatic that the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner's analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

Also, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

In contrast to the above, however, it is respectfully submitted that the Final Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — *a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.*

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any “evidence or sound scientific reasoning” and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See id. at 1222 & 1223; italics in original).

In the present case, the Final Office Action has not even properly asserted – let alone established -- in a conclusory way that undue experimentation would be required as to the rejected claims. Moreover, even as to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as explained above.

It is therefore respectfully requested that the enablement rejections be withdrawn in view of the foregoing.

Claims 18 to 25, 28 to 36 and 34 to 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0194170 (“Israni”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to

combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

It is respectfully submitted that obviousness rejections without documentary evidence “should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration.” MPEP   2144.03(A). The Israni document does not disclose the feature in which “digitally coded traffic information utilizing a subset of the possible options of the TMC message format or the ALERT-C Syntax and coding, transmitting, and decoding the digitally coded traffic information utilizing the subset” as the Office Action essentially admits. *Paper Number 20081121, p. 5.*

In accordance with MPEP   2144.03(C) and 37 CFR   1.104(d) (2), it is respectfully submitted that an Examiner’s affidavit should be provided to support the obviousness rejections as to the asserted steps (or items) that were present within the art at the time of the presently claimed subject matter. Accordingly, any Official Notice is traversed to the extent relied upon by the Office.

It is respectfully submitted that the Office’s assertion of obviousness does not address the required motivation to modify the real-time traffic broadcasts of Israni to provide the subject matter of claim 18. In particular, the assertion of obviousness does not address any motivation or suggestion as to why one of ordinary skill in the art would be motivated to expend additional time and effort in terms of program design, system development and testing to deviate from the RDS-TMC standard, when in doing so one might risk introducing into the design, for example, certain unforeseen consequences and/or future compatibility issues. To overcome this omission, the Final Office Action conclusorily asserts that the motivation for the modification would be “smaller traffic data.” However, since Israni clearly does not address the smaller traffic data issue, let alone suggest modifying the real-time traffic broadcasts as asserted, the Final Office Action essentially asserts that it would have been “*obvious to try*” the modification.

The Final Office Action hasn’t produced any proper evidence regarding what the ordinary skill level in the art is as to the presently claimed subject matter. In any case, the “obvious to try” rationale is clearly insufficient to support an obviousness rejection, particularly when the Final Office Action has not established any finding as to: a) whether the

problem addressed by the presently claimed subject matter was recognized in the art; or b) whether there was any recognized potential solution to the problem in the art.

Also, the Final Office Action appears to contend the traffic message conforms to the standard format for ALERT-C messages standard established in the RDS-TMC system as digitally coding traffic information according to a subset of possible options of predetermined technical standards. (*Paper Number 20081121, p.4*). It is respectfully submitted that mere conformity with a standard format for ALERT-C messages does not disclose or suggest coding of traffic information in accordance with a subset of possible options, where the options relates to at least one of a TMC message format and the ALERT-C Syntax. The traffic broadcast system utilizes RDS-TMC messages conform to the ALERT-C protocol. In the RDC/TMC system, many primary and some secondary road interchanges have predefined location numbers. These location numbers are a part of the traffic messages that are broadcast. In particular, these locations numbers are assigned by the road authorities or other parties involved in the development and maintenance of the RDS/TMC system.

These location numbers are standardized for all users. That is, any receiver that uses the messages from the traffic broadcast system is required to be able to relate the location reference numbers in the RDS-TMC messages to the known locations to which the numbers are assigned. (*Israni, p. 8, [0090]*). In stark contrast, the options relate to at least one of a TMC message format and the ALERT-C Syntax, and only a subset of possible options are being utilized to code traffic information. Even if Israni may indicate that the traffic message conforms to the standard format for ALERT-C messages established in the RDS-TMC system, such conformity merely acknowledges utilization and does not specifically disclose or suggest how a subset of possible options of predetermined technical standards may be used to digitally code traffic information, let alone the options relates to at least one of a TMC message format and the ALERT-C Syntax, as provided for in context of the claims.

Furthermore, the Final Office Action conclusorily asserts that not transmitting optional information results in saving transmission resources, and that if other information 50(n) field of traffic message 50 is not needed, it is not transmitted. (*Paper Number 20081121, p.13*). It is respectfully submitted that 50(n) merely represent components that provide other information and has nothing to do with options relating to at least one of a TMC message format and the ALERT-C Syntax. Specifically, the RDS-TMS messages system merely has a plurality of predefined location numbers pre-assigned to interchange for

roadways and is wholly silent as to whether the same format may be applicable to other information 50(n). (*Israni*, p. 8, [0090], [0096]).

Even if RDS-TMS message format may apply to other information 50(n) – which is not conceded for purposes of the response – *Israni* does not disclose or suggest how the presence or absence of field 50(n) may have an impact on how a subset of possible options of predetermined technical standards may be used to digitally code traffic information. The ability to include or exclude other information 50(n) and potential bandwidth savings notwithstanding, the traffic message 50, including 50(n), conforms with standard format for ALERT-C messages established in the RDS-TMC system. Significantly, the ‘optional’ field 50(n) does not code traffic information according to a subset of possible options of predetermined technical standard, nor does ‘optional’ field 50(n) represent the options relating to at least one of a TMC message format and the ALERT-C Syntax, and the traffic information does not make use of all the options.

To the extent that the Final Office Action appears to rely on ‘optional’ field 50(n), where 50(n) represents component that provide other information, rather than to address a subset of possible options, *Israni* does not disclose or suggest the feature of digitally coding traffic information according to a subset of possible options of predetermined technical standards, in which the subset of possible options of the predetermined technical standards is defined for the digitally coding the traffic information, the options relating to at least one of a TMC message format and the ALERT-C Syntax, and in which the traffic information does not make use of all the options and is always at least one of coded, transmitted, and decoded according to the subset.

Lastly, the Final Office Action does not specifically address the expressly recited features of the pending independent claims. The Final Office Action doesn’t fully treat every claim feature of claims 18, 25 and 31. Under the Office’s policy of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. (MPEP §707.07(g)). It is submitted that the present application is not sufficiently informal, does not present an undue multiplicity of claims, or exhibit a misjoinder of inventions, so as to reasonably preclude a complete action on the merits. Thus, it is respectfully submitted that by not expeditiously providing the information necessary to resolve issues related to patentability, this prevents the presentation

of appropriate patentability arguments and/or rebuttal evidence. (See The Official Gazette Notice of November 7, 2003).

Additionally, it is submitted that this needlessly encourages piecemeal prosecution, which is to be avoided as much as possible. (MPEP §707.07(g)). Accordingly, in the event that the Office maintains the rejection of any of the independent claims, it is respectfully requested, in the interests of compact prosecution, that the Office apply art against each feature of each rejected dependent claim, on the record, and with specificity sufficient to support a prima facie case of obviousness.

As further regards the obviousness rejections, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of

ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

It is believed and respectfully submitted that unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that the reference simply does not describe the features discussed above of the rejected claims.

Accordingly, it is submitted that claims 18, 25 and 31 are allowable, as are their respective dependent claims 19-24, 26, 28-30, 32, and 34-37.

Claims 27 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Israni in view of U.S. Patent No. 6,070,123 ("Beyer").

Claim 27 depends on claim 25, and claim 33 depends on claim 31. As explained above in connection with claims 25 and 31, Israni does not disclose or suggest the following: a) the digitally coded traffic information is transmitted according to predetermined regulations between a transmitter and at least one receiver . . . , in which a subset of possible options of the predetermined regulations is defined, the options relating to at least one of a TMC message format and the ALERT-C Syntax; and b) the digitally coded traffic information does not make use of all the options of the predetermined regulations. It is respectfully submitted that even if it were proper to modify the Israni reference in view of Beyer (which is not conceded), Beyer does not disclose or suggest the above-recited features which are also not disclosed or suggested by Israni.

It is therefore respectfully submitted that claims 27 and 33 are allowable for these further reasons.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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 (P. No. 36,197)

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